

### REMARKS

The present application relates to hybrid maize plant and seed 35Y54. Claims 5-8, 20, 33-42, 45-46, 49-52 and 55 have been canceled. Claims 44, 47-48, and 53-54 were previously canceled in the Preliminary Amendment submitted on July 30, 2003 and claims 9-19 and 21-32 were previously canceled in the Amendment of March 11, 2003. Claims 1 and 2 have been amended. Claims 56-69 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

#### Detailed Action

##### *A. Status of the Application*

Applicant acknowledges the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. § 1.114.

#### Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 8 remains rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the Office Action mailed April 30, 2003.

Applicant traverses this rejection. However, although not acceding to the Examiner's rejection, in order to expedite prosecution claim 8 has now been canceled, alleviating this rejection.

Claims 52 and 55 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner rejects claim 52 as indefinite in its dependence upon non-existent claim 62.

Applicant has now canceled claim 52, alleviating this rejection.

Claim 55 is rejected as indefinite in its recitation of "no statistically significant variation from 35Y54".

Applicant traverses this rejection. However, although not acceding to the Examiner's rejection, in order to expedite prosecution claim 55 has been canceled, thus alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 8, 33-40, 49-52 and 55 remain rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on page 5 in the Office Action mailed April 30, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 33-40, 49-52 and 55, thus alleviating this rejection.. Applicant has added new claims 56-69 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and request reconsideration.

Claims 8, 33-40, 49-52 and 55 remain rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention, as stated on page 5 in the Office Action mailed April 30, 2003.

In addition, Applicant herein submits the Summary of the Invention section has been amended to include the ATCC Accession Numbers of the inbred parents GE570932 and GE486862 on page 7 and the Deposits section has been amended in order to properly include both the hybrid maize plant 35Y54 and the inbred parents GE570932 and GE486862 and the corresponding ATCC Accession Numbers within the Deposit paragraph on page 48. The changes do not add new matter as there is literal support for the minor changes on page 7 in the originally filed specification. The Specification has now been amended to correct these minor changes. The Applicant further provides assurance that at least 2500 seeds of hybrid maize plant 35Y54 and the inbred parents GE570932 and GE486862 have been deposited with the ATCC.

Copies of the ATCC deposit receipts are included in this response. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02). Such action is respectfully requested.

In light of the above amendments and remarks, Applicant respectfully request reconsideration and withdrawal of the rejections to claims 8, 33-40, 49-52 and 55 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicant acknowledges that claims 1-7, 20, 41-43, and 46 are allowed.

Applicant further acknowledges that claims 1-10, 12-14, 16-18, 20-23, 25-27 and 29-31 are deemed free of the prior art. The Examiner further states the prior art fails to teach or fairly suggest the particularly claimed maize plants with their unique complement of genotypic and morphological characteristics, or methods of using them. This clearly indicates that hybrid maize plant 35Y54 as a whole is considered to be distinguishable from the prior art for the purposes of novelty and non-obviousness. Therefore, Applicant respectfully submits that the deposit of the representative seed of 35Y54 and inbred parents GE570932 and GE486862 should satisfy the description requirement. In light of the above, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, first paragraph as improper and requests reconsideration and withdrawal of these rejections.

Applicant further acknowledges that claims 56-69 have been agreed upon as allowable by Supervisory Patent Examiner Amy Nelson as aforementioned, thereby placing these claims in form for allowance. Applicant has canceled all non-allowable claims thereby placing the application in condition for allowance and has complied with all requirements of form set forth in previous office actions.

### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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